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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/775,591
Filing Date: February 05, 2001
Appellant(s): UKIGAWA ET AL.

Diallo Crenshaw
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/24/07 appealing from the Office action mailed 5/24/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5890137	Koreeda	07-1996
6609133	O'Leary et al.	5-1999

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Dogac, Asusman; Ozsu, M. Tamer & Ulusoy, Ozjur. Current Trends in Data Management Technology. Idea Group Publishing. 1999. Hershey, Pennsylvania. pp. 41 - 42.

Davis, Steven. Pragmatics: A Reader. Oxford University Press. New York, New York. 1991. pp. 217 - 219.

Lomax, Paul. Learning VBScript. O' Reilly & Associates, Inc. Sebastopol, California. 1997. pp. 457 - 459.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 2, 5 – 6, 12 – 13, 16, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koreeda (US Patent 5,890,137) in view of O'Leary (US Patent 6,609,113).

Regarding Claim 1, Koreeda discloses an online shopping system comprising:

- at least one user device (workstation) which is connected onto Internet (computer network) and for reading a merchant site (shopping mall) on the Internet (computer network). (see col. 5, line 33 – col. 6, line 2);

- an agent device (service center) which is connected to said at least one user device (workstation) and the merchant site (shopping mall), relays and sends a purchase instruction (product data) from said at least one user device (workstation) to the merchant site (shopping mall). (see col. 5, line 33 – col. 6, line 2);
- a settlement device (approval center) which is connected to the agent device (service center), and settles an account for a product purchased in accordance with the purchase instruction (product data) sent from said at least one user device (workstation). (see col. 5, line 33 – col. 6, line 2);
 - said at least one user device (workstation) including:
 - a purchase-instruction inputting means (product selection unit) for inputting an instruction for purchasing a product (selecting product) on sale in the merchant site (shopping mall). (see col. 2, lines 44 – 56);
 - a first purchase-instruction sending means for sending ID information of the user (personal data), as a first purchase instruction (first protocol), together with information regarding the product input (product data) by said instruction inputting means (product selection unit) to said agent device (service center). (see col. 2, lines 44 - 60);
 - said agent device (service center) including:

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- purchase-instruction receiving means for receiving the first purchase instruction sent (personal data, product data) from said first purchase instruction sending means. (see col. 2, lines 44 - 60);
- second purchase-instruction sending means for sending (distribution unit), as a second purchase instruction, information regarding the product (product data) and being included in the first purchase-instruction received by said instruction receiving means (supra), and information regarding the user (personal data) to the merchant site (shop systems). (see col. 6, line 53 – col. 7, line 2); and
- settlement requesting means for requesting said settlement device (approval center) for settling an account for the purchased product, based on the information regarding the product (product data) and being included in the instruction received by said purchase-instruction receiving means and the information regarding the settlement means (credit card data) of the user. (see col. 6, line 53 – col. 7, line 2).

Koreeda does not teach the underlined claim limitations.

An online shopping system comprising:

- said agent device including:

- user-information storage means for storing the ID information, user information regarding the user, and information regarding settlement means held by the user, in association with each other;
- user information extraction means for searching said user-information storage means for user information based on the ID information of the user which is included in the first purchase-instruction, and extracting corresponding information regarding the user and corresponding information regarding the settlement means, when said purchase-instruction receiving means receives the first purchase instruction;
- second purchase-instruction sending means for sending, as a second purchase instruction, information regarding the product and being included in the first purchase-instruction received by said instruction receiving means, and information regarding the user and being extracted by said user-information extraction means, to the merchant site; and
- settlement requesting means for requesting said settlement device for settling an account for the purchased product, based on the information regarding the product and being included in the instruction received by said purchase-instruction receiving means and the information regarding the settlement means of

the user and being extracted by said user-information extraction means.

O'Leary discloses an online shopping system comprising:

- said agent device (wallet) including:
 - user-information storage (database) means for storing the ID information (user ID), user information regarding the user, and information regarding settlement means held by the user, in association with each other. (see supra, col. 9, line 62 – col. 10, line 13 – It is inherent that an information storage means exists to allow the agent device (wallet) to store “form filling information” and “user’s ID”); and
 - user information extraction means for searching said user-information storage means for user information based on the ID information of the user (user ID) which is included in the first instruction, and extracting corresponding information regarding the user (ie. shipping address, name) and corresponding information regarding the settlement means (ie. credit cards), when said instruction receiving means (Internet transmission) receives the instruction. (see col. 15, line 19 – col. 16, line 55 – It is inherent that the system extracts user information from the storage means based upon the input of the ID information of user (user ID)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koreeda by incorporating a storage means for storing user information and settlement means information, as disclosed by O'Leary, and then extracting that information for use, as disclosed by O'Leary, to allow for minimal repeated user entry of information and automatic completion of forms.

Regarding Claim 2, Koreeda discloses an online shopping system wherein:

- said agent device (service center) further includes inquiry means for inquiring whether the settlement means is valid (credit authorization check), based on the information regarding the settlement means of the user (payment settlement data). (see col. 6, line 53 – col. 7, line 2); and
- said second purchase-instruction sending means (distribution center) inserting information representing that inquiring is performed (data approved by approval center) by said inquiry means into the second purchase-instruction (payment authorization), and sending the second purchase instruction to the merchant site (shop systems). (see col. 6, line 53 – col. 7, line 2).

Koreeda does not teach the underlined claim limitations.

An online shopping system wherein:

- said agent device further includes inquiry means for inquiring whether the settlement means is valid, based on the information regarding the settlement means of the user which is extracted by said user-information extraction means.

O'Leary discloses an online shopping system wherein:

- said agent device (wallet) further includes inquiry means for inquiring whether the settlement means is valid (sufficient balance), based on the information regarding the settlement means of the user (IPA account) which is extracted by said user-information extraction means (user information in database). (see col. 15, line 66 – col. 16, line 63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koreeda by incorporating a storage means for storing user information and settlement means information, as disclosed by O'Leary, and then extracting that information for use, as disclosed by O'Leary, to allow for minimal repeated user entry of information and automatic completion of forms.

Regarding Claim 5, neither Koreeda nor O'Leary teach an online shopping system wherein:

- said agent device and said settlement device are connected with each other through a private line.

Utilizing a private line or a private network for data transmission is old and well known in the art of computer system design. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koreeda and O'Leary to connect any portions of the system – the user device, the agent device or the settlement device – together using a private line for data transmission, to allow for faster and more secure data transmission between system components.

Regarding Claim 6, further method claim would have been obvious from system claims rejected above, Claims 1 – 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 12, further device claim would have been obvious from system claims rejected above, Claims 1 - 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 13, further device claim would have been obvious from system claims rejected above, Claims 1 - 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 16, further method claim would have been obvious from system claims rejected above, Claims 1 - 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 20, further computer readable medium claim would have been obvious from system claims rejected above, Claims 1 - 3, and is therefore rejected using the same art and rationale.

Regarding Claim 23, further computer readable medium claim would have been obvious from system claims rejected above, Claims 1 - 3, and is therefore rejected using the same art and rationale.

Claims 7, 9 – 11, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koneeda in view of Dogac (Dogac, Asuman, Ozsu, M. Tamer & Ulusoy, Ozgur. *Current Trends in Data Management Technology*. Idea Group

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Publishing. Hershey, PA. 1999. pp. 41 – 42) and Davis (Davis, Steven. *Pragmatics: A Reader*. Oxford University Press. New York, New York. 1991. pp. 217 – 219).

Regarding Claim 7, Koneeda discloses a user device (workstation) which is connected to Internet (computer network), browses a merchant site (shopping mall) on the Internet (computer network), and sends an instruction for purchasing a product on sale (product data) in the merchant site (shopping mall) said user device comprising:

- purchase-instruction inputting means (product selection unit) for inputting a purchase instruction of a product on sale (selecting product) in the browsed merchant site (shopping mall). (see col. 2, lines 44 – 56);
- product-information downloading means for extracting (downloading) information regarding a product to be purchased (product data) from contents of the browsed merchant site (shopping mall). (see col. 6, lines 32 - 54); and
- purchase-instruction sending means (transmission unit) for sending, as a purchase instruction, the information regarding the product (product data) and being downloaded by said product-information downloading means (downloaded) and the information regarding the settlement means, together with ID information of a user (personal data), to an agent device (service center) which is prepared separately from the merchant site (shopping mall) and intermediates in a purchase process between the merchant site (shopping mall) and said user. (see col. 6, lines 32 – col. 7, line 2).

Koreeda does not teach the underlined claim limitations.

A user device comprising:

- product-information extraction means for extracting information regarding a product to be purchased from contents of the browsed merchant site and information regarding specified settlement means; and
- purchase-instruction sending means for sending, as a purchase instruction, the information regarding the product and being extracted by said product-information extraction means and the information regarding the settlement means, together with ID information of a user, to an agent device which is prepared separately from the merchant site and intermediates in a purchase process between the merchant site and said user.

Extraction of information from merchant sites is old and well known in the arts of information technology and e-commerce, as evidenced by Dogac which states "Shopbot is able to visit over a dozen of software vendors, extract information, and summarize results for the user." (see p. 41). It would have been obvious to one with ordinary skill in the art to have modified Koneeda to have incorporated the ability to extract information from merchant websites, as disclosed by Dogac, to allow for use of a third-party procurement and settlement system with existing merchant sites on the world-wide web.

Specifying settlement means, such as acceptable credit cards, by a retailer or seller, either in an online environment or in a brick-and-mortar environment, is old and well known in the art of sales and retailing, as evidenced by Davis which references a

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potential patron calling a restaurant to inquire about acceptable forms of payment for a planned future purchase. (see The Caller's Plan, p.218). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modified Koneeda, Dogac and Davis to allow for the extraction of information regarding settlement means to allow for individual sellers to specify settlement means and receive payment in said specified settlement means.

Neither Koneeda, Dogac nor Davis teach that the gathering of "information regarding settlement means" is automatic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding Claim 9, Koneeda discloses a user device wherein:

- said purchase-instruction inputting means (product selection via download and transmission of selected product data to service center) is prepared separately from instruction means included in the contents of the browsed merchant site (product selection via website). (see col. 2, lines 44 – 56).

Regarding Claim 10, Koneeda discloses a user device (workstation) wherein said processor executes the program stored in said memory, thereby:

- accessing said merchant site (shopping mall) from said communications device (transmission unit), and controlling said communications device to receive contents of said merchant site. (see col. 5, line 33 – col. 6, line 2);

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- displaying the contents of the merchant site which are received by said communications device on said display device (see figure 5);
- permitting the user to input an instruction for purchasing a product on sale in the contents of the merchant site which are displayed on said display device (see MARK button – figure 5);
- downloading information (downloading) regarding the product to be purchased (product data) from the contents of the merchant site (shopping mall) displayed on said display device. (see col. 6, lines 32 – 54); and
- controlling said communications device (transmission unit) to send, as a purchase instruction, downloaded (downloaded) information regarding the product (product data), together with ID information of the user (personal data) to an agent device (service center), which is prepared separately from the merchant site (shopping mall) and intermediates in a product purchase process between said user device (work station) and said merchant site (shopping mall). (see col. 6, lines 32 – col. 7, line 2).

Koreeda does not teach the underlined claim limitations.

A user device wherein said processor executes the program stored in said memory, thereby:

- extracting information regarding the product to be purchased from the contents of the merchant site displayed on said display device and information regarding specified settlement means; and

- controlling said communications device to send, as a purchase instruction, extracted information regarding the product and the information regarding the settlement means, together with ID information of the user to an agent device, which is prepared separately from the merchant site and intermediates in a product purchase process between said user device and said merchant site.

Extraction of information from merchant sites is old and well known in the arts of information technology and e-commerce. As evidenced by Dogac which states "Shopbot is able to visit over a dozen of software vendors, extract information, and summarize results for the user." (see p. 41). It would have been obvious to one with ordinary skill in the art to have modified Koneeda to have incorporated the ability to extract information from merchant websites, as disclosed by Dogac, to allow for use of a third-party procurement and settlement system, as disclosed by Koneeda, with existing merchant sites on the world-wide web.

Specifying settlement means, such as acceptable credit cards, by a retailer or seller, either in an online environment or in a brick-and-mortar environment, is old and well known in the art of sales and retailing, as evidenced by Davis which references a potential patron calling a restaurant to inquire about acceptable forms of payment for a planned future purchase. (see The Caller's Plan, p.218). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modified Koneeda, Dogac and Davis to allow for the extraction of information regarding settlement means

to allow for individual sellers to specify settlement means and receive payment in said specified settlement means.

Neither Koneeda, Dogac nor Davis does not teach that the gathering of "information regarding settlement means" is automatic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding Claim 11, further method claim would have been obvious from device claim rejected above, Claim 10, and is therefore rejected using the same art and rationale.

Regarding Claim 18, further computer readable medium claim would have been obvious from device claim rejected above, Claim 10, and is therefore rejected using the same art and rationale.

Regarding Claim 22, further program data signal claim would have been obvious from device claim rejected above, Claim 10, and is therefore rejected using the same art and rationale.

Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koreed, Dogac and Davis, as in Claims 7 and 18 above, in further view of Lomax (Lomax, Paul. *Learning VBScript*. O'Reilly & Associates, Inc. Sebastopol, California. 1997. pp. 457 – 459).

Regarding Claim 8, neither Koneeda, Dogac nor Davis teach a user device further comprising:

- merchant-site determination means for determining whether the merchant site is browsed; and
- instruction-input permission means for permitting, when said merchant-site determination means determines that the merchant site is browsed, an input of an instruction from said purchase-instruction inputting means.

User-tracking and session-tracking on merchant sites via cookies and objects are old and well-known in the art of computer programming and e-commerce system design, as evidenced by Lomax which states "For instance, some shopping cart software utilizes a cookie file on your hard drive to store order information as you browse the store. Then, when you reach the virtual check-out counter, the cookie file is read back into the final order page. Other shopping cart applications assign you a unique number as you enter the site." (see pp. 457 – 458). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koneeda, Dogac and Davis by incorporating a merchant-site determination means (cookie or object), as disclosed by Lomax, to allow for tracking of a user's browsing of a merchant site, and incorporating an instruction-input permission means (cookie detection) for permitting, when said determination means determines the merchant site is browsed (cookie), an input of an instruction from said purchase-instruction inputting means (submission of shopping cart), to allow for tracking of a user and linking that user's order with a particular merchant site.

Regarding Claim 19, further computer readable medium claim would have been obvious from device claim rejected above, Claim 8, and is therefore rejected using the same art and rationale.

(10) Response to Argument

Structural Differences Between Cited Prior Art Reference(s)

Appellant argues that structural differences that exist between the prior art references, Koreeda and O'Leary, prevents their combination. Specifically, Appellant argues that the two lines of communication in Koreeda – (1) between user and shopping mall and (2) between user and service center – is therefore incompatible with the one line of communication in O'Leary – (1) between user and merchant site.

Appellant asserts that in Koreeda “two separate systems (4 and 6) are required,” such “systems” being networks enabling communication between computer systems. Computer network 4 is the computer network connecting a user's system with shopping malls, essentially on-line catalogs and on-line retailers, while computer network 6 connects the user's system with a service center, allowing processing of a submitted order and settlement.

Appellant asserts that O'Leary operates differently to that of Koreeda, as O'Leary has only one line of communication, a line of communication between “a workstation 200 and a merchant site.”

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Firstly, even if Appellant's assertions are accurate, which Examiner does not concede, Examiner fails to see how such structural differences between Koreeda and O'Leary prevents their combination.

Koreeda states:

The user decides the product he or she wants to buy via a computer network (Internet) from a user system. Then, a transmission unit calls up a service center to send order data including the credit card data via a settlement network. Service center invoices the sales price to an approval center based on the order data. Approval center pays the price to service center. Then, service center sends the order data to the shopping system. A delivery processing unit then delivers the product to the user based on the order data. (emphasis added - see abstract).

O'Leary states:

Upon receipt of an electronic purchase message from a merchant web site 255 as will be further described below with respect to the method of FIG. 2, the PPP enhanced Wallet 215 user is able to: 1) approve a purchase; 2) initiate the payment through a payment authorization to the consumer's bank 220; 3) verify the accuracy of the merchant's payee information (identification of the merchant's account 235 at the merchant's bank 275); 4) generate a purchase confirmation 244 that is transmitted to the merchant web site 255 or VPL reporter 240; and 5) generate a receipt that can be stored at the server hosting the PPP enhanced Wallet 215 or the user's storage (e.g., hard drive) on workstation 200. (emphasis added – see col. 10, line 13 - 35).

In both Koreeda and O'Leary, a user accesses a merchant site and selects a product to purchase, the user sends information to an agent device, either termed a service center (Koreeda) or a wallet (O'Leary), which then routes information back to the merchant site upon completion. Examiner fails to see the structural differences which would make the two systems incompatible.

Secondly, Examiner refutes the Appellant's interpretation of the cited prior art.

Appellant asserts that "the settlement of payment for the product to be purchased requires of a separate settlement network" and cites col. 5, lines 48 – 50 (reproduced below) as evidence of such.

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The settlement of the product to be purchased is performed by using a settlement network 6. Settlement network 6 connects user system 5 with a service center 7, for instance, TCP/IP (Transmission Control Protocol/Internet Protocol) is adapted, and a public line is used. (col. 5, lines 48 – 50).

The cited passage does not state that the networks are separate, although some passages state that the networks “may” be separate. However, Koreeda also states that the service center could exist within the same computer network as the shopping mall, perhaps as a subcomponent of the overall system.

In the on-line shopping system, the shopping mall network may be a computer network that can be accessed by a third party, and the settlement network may be a network set separately between the user system and the service center.

In the on-line shopping system, the shopping mall network may be Internet.

In the on-line shopping system, the settlement network may be formed by a public line, wherein the first protocol may be Point-to-Point Protocol, wherein the second protocol may be a protocol which is used between the shop system and the approval center for a shopping by the credit card.

A payment settlement method may include a store system offering shopping malls, a user system that may select a product to be purchased from the shopping malls, a credit card company system that may approve a payment settlement with a credit card, and a service center which may exist among the store system. the user system and the credit card company system, the payment settlement method may further include...”(emphasis added, see col. 3, lines 40 – 59).

Appellant asserts that O’Leary operates differently to that of Koreeda, as O’Leary has only one line of communication, a line of communication between “a workstation 200 and a merchant site.”

However, O’Leary states:

The user’s log-in to the PPP enhanced Wallet 215 is secure and encrypted to protect the confidentiality of any financial information associated with the operation of the PPP enhanced Wallet 215. Once accessed, a window containing the PPP enhanced Wallet 215 is launched on the workstation 200 and remains open during the user’s session. The PPP enhanced Wallet 215 window has the ability to communicate with other open browser windows. In a preferred embodiment, the user’s connection to the PPP enhanced Wallet 215 is through the Internet. In an alternative embodiment, the connection from the user’s workstation 200 to the PPP enhanced Wallet 215 software can be through a separate dial up line or third party private network. (emphasis added – see col. 9, lines 49 – 61).

The cited passage indicates that the line of communication connecting the user with the agent device, such as the wallet, may be a separate line of communication than the line of communication connecting the user and the merchant site.

Failure to Teach Claim Limitations

Appellant argues that there is no teaching of a "centralized storage of user data, settlement data and ID information at the [agent device] for plural users." (see Appeal Brief, p. 13).

However, Examiner was unable to locate Claims that relate to a centralized storage of user data for use by plural users. Claim 1 does contain claim language that "said agent device including user-information storage means for storing the ID information, user information regarding the user, and information regarding settlement means held by the user, in association with each other."

To this end, O'Leary discloses:

The user's log-in to the PPP enhanced Wallet 215 is secure and encrypted to protect the confidentiality of any financial information associated with the operation of the PPP enhanced Wallet 215. Once accessed, a window containing the PPP enhanced Wallet 215 is launched on the workstation 200 and remains open during the user's session. The PPP enhanced Wallet 215 window has the ability to communicate with other open browser windows. In a preferred embodiment, the user's connection to the PPP enhanced Wallet 215 is through the Internet. In an alternative embodiment, the connection from the user's workstation 200 to the PPP enhanced Wallet 215 software can be through a separate dial up line or third party private network.

As one of its primary functions, the PPP enhanced Wallet 215, though the functions provided by the PPP 227 serves as the portal to an Internet Payment Account (IPA) or a DDA account 230 described in more detail below. **In a preferred embodiment the PPP enhanced Wallet 215 stores the following types of information: Form filling information such as credit card numbers, debit card numbers, shipping addresses, alternate shipping addresses,** frequent flyer accounts, membership discounts (e.g., AAA, AARP), loyalty programs and e-mail addresses; Discount information such as e-

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coupons, rebates and merchant-specific spending certificates; Points or miles accrued for use of the accounts associated with the PPP 227; and Convenience information such as frequently paid VPL #'s (described below), bill payment account #'s, receipts, e-commerce bookmarks, shopping lists. A preferred download folder is installed on the user's local hard drive. The PPP enhanced Wallet 215 has pull down menus that are used to select, edit, update, sort, import and export any of the above information. (emphasis added – see col. 9, line 49 – col. 10, line 13).

Examiner asserts that O'Leary discloses an agent device (the wallet) including user-information storage means for storing the ID information (user log-in ID), user information regarding the user (shipping addresses) and information regarding settlement means (credit card numbers) held by the user, in association with each other (associated in storage by virtue of user log-in ID).

Appellant argues that there is no teaching of "user ID information, as a data separate from personal data, sent from the user system to the [agent device]." (see Appeal Brief, p. 13).

However, Examiner was unable to locate claims that relate to user ID information being separate and unrelated data from person data. Examiner would like to assert that even if such claim language was present that such terms as "user ID information" and "personal data" are so overly broad that there are multiple disclosures within each reference that could read upon such terms. As such, the broadest definition for the term was applied as to provide the "broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims." See *In re Prater and Wei*, 162 USPQ 541, 550 (CCPA 1969).

Appellant argues that there is no disclosure that a user sends a purchase instruction for sending user ID information, as a purchase instruction, together with

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information regarding the product from the user to an agent device, Examiner respectfully disagrees.

Koreeda states:

The user decides the product he or she wants to buy via a computer network (Internet) from a user system. Then, a transmission unit calls up a service center to send order data including the credit card data via a settlement network. (emphasis added - see abstract).

Service center 7 receives the order data of the product data, personal data, and payment settlement data 21 from user system 5. (emphasis added - see col. 5, lines 52 - 54).

Examiner asserts that such excerpts disclose a user sending a purchase instruction (transmission of order submission) for sending user ID information (personal data), as a purchase instruction (transmission), together with information regarding the product (product data) from the user to an agent device (the service center).

Furthermore, O'Leary states:

As one of its primary functions, the PPP enhanced Wallet 215, though the functions provided by the PPP 227 serves as the portal to an Internet Payment Account (IPA) or a DDA account 230 described in more detail below. In a preferred embodiment the PPP enhanced Wallet 215 stores the following types of information: Form filling information such as credit card numbers, debit card numbers, shipping addresses, alternate shipping addresses, frequent flyer accounts, membership discounts (e.g., AAA, AARP), loyalty programs and e-mail addresses; Discount information such as e-coupons, rebates and merchant-specific spending certificates; Points or miles accrued for use of the accounts associated with the PPP 227; and Convenience information such as frequently paid VPL #'s (described below), bill payment account #'s, receipts, e-commerce bookmarks, shopping lists. A preferred download folder is installed on the user's local hard drive. The PPP enhanced Wallet 215 has pull down menus that are used to select, edit, update, sort, import and export any of the above information.

Upon receipt of an electronic purchase message from a merchant web site 255 as will be further described below with respect to the method of FIG. 2, the PPP enhanced Wallet 215 user is able to: 1) approve a purchase; 2) initiate the payment through a payment authorization to the consumer's bank 220; 3) verify the accuracy of the merchant's payee information (identification of the merchant's account 235 at the merchant's bank 275); 4) generate a purchase confirmation 244 that is transmitted to the merchant web site 255 or VPL reporter 240; and 5) generate a receipt that can be stored at the server hosting the PPP enhanced Wallet 215 or the user's storage (e.g., hard drive) on workstation 200. (emphasis added - see col. 9, line 62 - col. 10, line 35).

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Examiner asserts that such excerpts disclose a user sending a purchase instruction (purchase approval) for sending user ID information (form-filled information such as shipping information or e-mail addresses), as a purchase instruction (purchase submission), and information regarding the product (discount information) from the user to an agent device (the wallet).

Appellant argues that, in O'Leary, "[t]here is no teaching or suggestion that the user ID information is stored in connection with user information and settlement means information...[and] there is no extraction on the basis of ID information." (see Appeal Brief, pp. 20 – 21).

To this end, O'Leary discloses:

The user's log-in to the PPP enhanced Wallet 215 is secure and encrypted to protect the confidentiality of any financial information associated with the operation of the PPP enhanced Wallet 215. Once accessed, a window containing the PPP enhanced Wallet 215 is launched on the workstation 200 and remains open during the user's session. The PPP enhanced Wallet 215 window has the ability to communicate with other open browser windows. In a preferred embodiment, the user's connection to the PPP enhanced Wallet 215 is through the Internet. In an alternative embodiment, the connection from the user's workstation 200 to the PPP enhanced Wallet 215 software can be through a separate dial up line or third party private network.

As one of its primary functions, the PPP enhanced Wallet 215, though the functions provided by the PPP 227 serves as the portal to an Internet Payment Account (IPA) or a DDA account 230 described in more detail below. **In a preferred embodiment the PPP enhanced Wallet 215 stores the following types of information: Form filling information such as credit card numbers, debit card numbers, shipping addresses, alternate shipping addresses,** frequent flyer accounts, membership discounts (e.g., AAA, AARP), loyalty programs and e-mail addresses; Discount information such as e-coupons, rebates and merchant-specific spending certificates; Points or miles accrued for use of the accounts associated with the PPP 227; and Convenience information such as frequently paid VPL #'s (described below), bill payment account #'s, receipts, e-commerce bookmarks, shopping lists. A preferred download folder is installed on the user's local hard drive. The PPP enhanced Wallet 215 has pull down menus that are used to select, edit, update, sort, import and export any of the above information. (emphasis added – see col. 9, line 49 – col. 10, line 13).

Examiner asserts that as logging into the wallet allows access to stored user information, such as shipping addresses, and settlement means information, such as

credit card numbers, that there must inherently be an association between the user ID and accessed information, as provision of one piece of data provides access to the other pieces of data. Furthermore, as the accessed information is recalled from a storage means, allowing for automated form-filling functions, there must inherently be an extraction means to pull this data from storage.

Failure to Teach Claim Limitations – Claim 6

Appellant argues that an additional claim limitation contained within Claim 6 that of “pre-registering ID information of the user, information regarding the user, and information regarding settlement means held by the user, in association with each other in a database of said agent device” is not taught nor suggested by the cited prior art.

However, Examiner asserts as argued previously that O’Leary discloses that such information is held in association with each other. Furthermore, pre-registration of such information is inherent for the form-filling functions of O’Leary, for if the information was not pre-registered (stored prior to use) within the wallet, the wallet would be unable to retrieve such information and populate forms using such information.

Dogac and Davis References

Appellant argues that one of ordinary skill in the art would not have been led to combine the teachings of Dogac, which relates to extraction of information from merchant websites by computerized agents, and Davis, which relates to a linguistic

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study concerning questioning merchants about accepted credit cards for settlement purposes, with those of Koreeda and O'Leary, which relate to online shopping systems.

Examiner asserts that the Courts have stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR Int'l Co. v. Teleflex, Inc.* 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

In the instant case, the cited prior art references were available at the time of the purported invention. The Applicant merely implemented a variation of the existing elements present within the prior art in establishing his/her own invention, either through substitution and/or combination of such prior existing elements. Where, as here "[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result," *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395 (citing *United States v. Adams*, 383 U.S. 50-51, 148 USPQ 479, 483 (1966)). Furthermore, in the instant case, each incorporated element performs the same function and/or provides the same utility as intended in their original state, and therefore yields a predictable result.

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Dogac states:

An earlier example of a software agent for electronic commerce is ShopBot (shopping Robot) [Doorenbos, 1997] which is a domain-independent comparison-shopping agent. Given the home pages of several online stores, ShopBot automatically learns how to shop at these vendors. Learning process involves extracting product descriptions from home pages...After learning, ShopBot is able to visit over a dozen of software vendors, extract product information and summarize the results for the user. (see p. 41).

Examiner asserts that based upon the disclosure of Dogac that one of ordinary skill in the art would have modified Koreeda and O'Leary to extract information from the merchant site, as disclosed by Dogac, allowing for automated extraction of information from merchant sites rather than manual searching and recording of such information by the user.

Davis discloses a thought and communication process through which a user, such as a potential consumer, would inquire from a merchant, such as a restaurant, whether they accept different settlement means, such as credit cards.


Examiner asserts that based upon the disclosures of Davis that one of ordinary skill in the art would have modified Koreeda, O'Leary and Dogac to extract information from the merchant concerning the settlement means that would be accepted by the merchant for settlement purposes, as disclosed by Davis, thereby allowing the transaction to proceed to its intended conclusion, payment.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

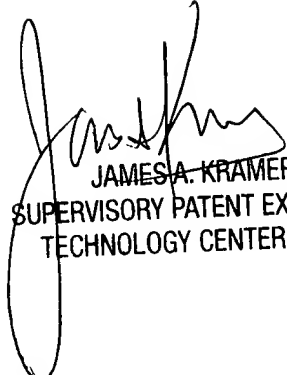
Jason Borlinghaus 

September 2, 2007

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